Supreme Court, U.S.
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No. 01-1791

IN THE

Supreme Court of the United States

FATA ALUMINUM, INC. and FATA GROUP, S.p.A.,

Petitioners

v.

VULCAN ENGINEERING CO., INC.,

Respondent

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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49 pp

QUESTION PRESENTED

Whether this Court should decide the issue made the basis of the petition when that issue was neither raised in nor passed upon by the court of appeals and the court of appeals held that the district court's findings of fact are not clearly erroneous?

INFORMATION REQUIRED BY RULE 29.6

Respondent, Vulcan Engineering Co., Inc., has no parent corporation and no publicly held company owns 10% or more of its stock.

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STATEMENT OF THE CASE

Petitioners state in their petition for a writ of certiorari that "[t]his petition does not concern the factual determinations made below." (Pet. at 3). The Court would be seriously misled, however, if it relied on petitioners' statement of the case without comparing it to the opinions below. Despite their concession that they do not contest "the factual determinations made below," petitioners have in fact contested those findings. Petitioners have strung together a series of alternative findings of fact which the district court was not compelled to make based on the evidence contained in the record. As a result, respondent is obliged to provide its own statement of the case in order to bring to the Court's attention the numerous misstatements and omissions in the petition. *See* Sup. Ct. Rule 15.2.[1]

A. The District Court's Decision.

This case was tried to the district court for seven days in March 1999. (Pet. App. 29a). The parties then filed post-trial briefs and the district court heard oral argument on the issues presented. (*Id*). The district court issued its memorandum opinion and judgment in favor of respondent in August 1999. (Pet. App. 27a-73a). The court held that "in its attack under 35 U.S.C. § 103, FATA did not come

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1. In addition to misstating the findings of fact, reasoning and holding of the district court on the issue of obviousness, as well as the reasoning and holding of the court of appeals, petitioners have also misstated, among other things: (1) the description of respondent's invention (Pet. at 3-4); (2) the operation of respondent's invention (Pet. at 5, 13); (3) the scope and content of the prior art (Pet. at 5-6, 14); and (4) the differences between respondent's invention and the prior art (Pet. at 6, 15). The Court would likewise be misled if it relied on the alleged holdings and truncated quotations from the cases cited in the petition without examining the cases themselves.

close to rebutting the statutory presumption of validity, 35 U.S.C. § 282, that attaches to the '787 patent by establishing that Claim 1 of the '787 patent was invalid." (Pet. App. 58a). The court also held that petitioners infringed respondent's patent. (Pet. App. 31a, 72a-73a).

The court began its discussion of "obviousness" under 35 U.S.C. § 103 by stating that the court

> must determine whether the claimed invention would have been obvious as a legal matter, based on underlying factual inquiries including: (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the claimed invention and the prior art, and (4) secondary considerations of nonobviousness.

(Pet. App. 50a).

This is the precise test set forth by this Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In *Graham*, the Court held that "[w]hile the ultimate question of patent validity is one of law, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries." 383 U.S. at 17. Under § 103, the Court explained, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *Id.* The Court in *Graham* also stated that "commercial success" "may have relevancy." *Id.* at 17-18.

The district court in this case applied the three primary *Graham* factors to the facts before it and concluded that "[n]one of the lost foam prior art discussed above made Claim 1 obvious." (Pet. App. 57a). In analyzing the scope and content of the prior art, the court found as a fact that

"[n]one of these references disclose a metal casting system in which all of the stations are online." (Pet. App. 44a). In fact, "[a]ll prior art identified at trial utilized accumulating systems." (Pet. App. 34a). The court rejected petitioners' reliance on three other lost foam systems. The court found as a fact that the Rochester Products system, which did not use pivotally-mounted gondolas and did not have a track, "was experimental and not used in production. Apparently it was assembled in-house, used for a short period of time, and then abandoned." (Pet. App. 52a). The Rochester Products system, the court found, "is not prior art because of its experimental and secret nature." (Pet. App. 52a). The court also found that, assuming the Rochester Products system was prior art, "nothing in Rochester Products suggests or teaches the invention claimed in the '787 patent individually or in combination with the other cited art." (Pet. App. 52a).

Similarly, the court found that the Fredonia system was "a conventional power-and-free accumulating system" rather than a non-accumulating, continuously-linked conveyer system claimed in respondent's '787 patent. (Pet. App. 52a). Based on this and other differences, the court found that "[t]here is nothing in Fredonia that teaches or suggests the invention claimed in the '787 patent individually or in combination with the other cited prior art." (*Id*). Finally, the court found that the John Deere system, another accumulating system, "never really operated as a production system and is no longer in service." (Pet. App. 53a). Based on this and other differences, the court found, once again, that "[t]here was nothing in John Deere which suggests or teaches the invention claimed in the '787 patent individually or in combination with the other cited prior art." (*Id*).

The court then addressed petitioners' argument that "the prior art references [they] cited would have lead a person of ordinary skill in the art to combine them in the way described in Claim 1." (Pet. App. 53a). The court stated that

"[t]here was no dispute at trial as to the level of ordinary skill in the art." (Pet. App. 51a). *See Graham v. John Deere Co.*, 383 U.S. at 17. In rejecting petitioners' argument, the court found as a fact that "[t]he '787 patent calls for compaction online; neither FATA nor any other manufacturer except Vulcan offered a continuously-linked conveyor with the compaction station online." (Pet. App. 55a). The court further found that

> no witness of ordinary skill in the art testified that [respondent's] combination is the result of common engineering skill. . . . The conventional wisdom in the industry was that if all casting stations were to be located on a single conveyer, the flasks had to be allowed to move independently of each other and accumulate at the operating station.

(Pet. App. 55a).

The court next addressed the differences between the claimed invention and the prior art. *See Graham v. John Deere Co.*, *supra*. The court found as a fact that

> there were significant differences between [Rochester Products], Fredonia, and John Deere and the invention described in the '787 patent. Each prior art reference cited by FATA was an accumulating system. None of the references individually or in combination suggested the motivation to place the compaction station online and use a continuously-linked conveyer system, as [respondent] did.

(Pet. App. 56a). Based on the three primary factors set forth in *Graham*, the court held that respondent's '787 patent was "not obvious" within the meaning of § 103. (Pet. App. 30a, 57a).

Finally, the district court discussed the "secondary consideration" of commercial success. (Pet. App. 56a-57a). This too is consistent with this Court's decision in *Graham v. John Deere Co., supra.* In *Graham*, the Court stated that "[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter to be patented." 383 U.S. at 17-18. This additional factual inquiry "may have relevancy." *Id.* at 18. The district court in this case in no way intimated anywhere in its opinion, much less held, that the fact of commercial success "trumped" the three primary factors discussed in *Graham* or was the determining factor of validity. (*See* Pet. App. 49a-57a). The court simply stated that the commercial success of respondent's invention merely supported its earlier finding that application of the three primary *Graham* factors demonstrated that respondent's patent was not obvious. (Pet. App. 56a-57a).

The district court neither addressed nor passed upon the issue made the basis of the petition — whether the Federal Circuit has improperly superseded this Court's test of obviousness under 35 U.S.C. § 103 — because petitioners did not raise that issue in the district court. This is made plain by the district court's opinion as well as the post-trial brief filed by petitioners in the district court. (*See* Pet. App. 27a-72a; Petitioners' Post-Trial Brief, pp. 25-35).

B. The Court Of Appeals' Decision.

The court of appeals issued its decision in this case on February 5, 2002. (Pet. App. 1a). The court affirmed the district court's judgment "with modification of the damages award." (Pet. App. 2a, 19a). The court remanded the case "for a determination of whether Vulcan established facts supporting its position that but for the infringement it would

have obtained a higher price, and if so, the reassessment of damages for line 1." (Pet. App. 15a). Judge Michel agreed with the majority's decision on the issues of validity and infringement but dissented from the majority's opinion on the issue of damages, stating that he "would vacate and remand the court's determination about the damages for the infringing offers to sell lines 2-5." (Pet. App. 26a).

The court of appeals held that the district court's findings of fact are not clearly erroneous and "affirm[ed] the ruling that the patent is not invalid." (Pet. App. 7a). In reaching its holding on the issue of validity, the court applied the *Graham* factors to the facts found by the district court. (Pet. App. 4a-6a). The court also discussed very briefly the commercial success of respondent's '787 patent. (Pet. App. 6a). The court's discussion of "commercial success" consists of one paragraph only. (Pet. App. 6a). Contrary to the assertion throughout the petition, the court of appeals in no way intimated, much less held, that the "secondary consideration" of commercial success "trumped" the three primary *Graham* factors as petitioners would have this Court believe. (Pet. App. 4a-7a).

The court of appeals neither addressed nor passed upon the issue made the basis of the petition because petitioners did not even remotely raise that issue in the court below. Once again, this is obvious from the court's opinion as well as the briefs filed by petitioners in the court below. (*See* Pet. App. 1a-19a; Appendix to this Brief ("App.") 1a-15a).

REASONS FOR DENYING THE WRIT

Petitioners have failed to present any "compelling reasons" for the issuance of a writ of certiorari. Sup. Ct. Rule 10. The issue made the basis of the petition — whether the court of appeals improperly superseded this Court's test

of obviousness under 35 U.S.C. § 103 — was neither raised in nor passed upon by the court of appeals. (Pet. App. 1a-19a; App. 1a-15a). The court of appeals held that the district court's findings of fact are not clearly erroneous. (Pet. App. 7a). The decision below is also correct. This case simply does not present any issue of substantial importance warranting consideration by the Court.

I. The Issue Made The Basis Of The Petition Was Neither Raised In Nor Passed Upon By The Court Of Appeals.

This Court's normal practice is to refrain from deciding issues "not presented to, or ruled on by," the court below. *Bray v. Alexandria Women's Health Clinic*, 506 U.S. 263, 279 (1993). *Accord Lopez v. Davis*, 531 U.S. 230, 244 n.6 (2001); *Glover v. United States*, 531 U.S. 198, 205 (2001); *National Collegiate Athletic Ass'n v. Smith*, 525 U.S. 459, 470 (1999); *Holly Farms Corp. v. NLRB*, 517 U.S. 392, 400 n.7 (1996); *EEOC v. Federal Labor Relations Auth.*, 476 U.S. 19, 24 (1986). Petitioners have offered no reason why the Court should depart from its normal practice in this case.

In this case, the court of appeals neither addressed nor passed upon the issue made the basis of the petition because petitioners did not raise that issue in the court below. (*See* Pet. App. 1a-19a; App. 1a-15a). The issue made the basis of the petition "could hardly be less suitable for [the Court's] review" because petitioners seek review of an issue "not presented to, or ruled on by, any lower court." *Bray v. Alexandria Women's Health Clinic*, 506 U.S. at 279. *See, e.g., Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 39 (1997) ("Whether, if the issue were

squarely presented to us, we would reach a different conclusion than did the Federal Circuit is not a question we need decide today.").[2]

II. The Court Of Appeals Held That The District Court's Findings Of Fact Are Not Clearly Erroneous.

This Court has a long-standing practice of not reversing findings of fact concurred in by two lower courts in the absence of a very obvious and exceptional showing of error. *See, e.g., Blau v. Lehman*, 368 U.S. 403, 408-09 (1962); *Faulkner v. Gibbs*, 338 U.S. 267, 268 (1949) (patent case); *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 275 (1949) (patent case); *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 278 (1944) (patent case); *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, 367 (1942) (patent case). There is no such obvious and exceptional showing of error here.[3]

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2. Petitioners essentially seek an advisory opinion from the Court. Petitioners' focus on language from *other* cases previously decided by the Federal Circuit does not warrant issuance of the writ *in this case* because a decision on the merits of an issue not decided below "would be inconsistent with [the Court's] constitutional inability to render advisory opinions." *Bell v. Maryland*, 378 U.S. 226, 236 (1964); *see also Princeton University v. Schmid*, 455 U.S. 100, 102 (1982) ("We do not sit to decide hypothetical issues or to give advisory opinions.").

3. A finding of fact is "clearly erroneous" only if " 'the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed.' " *Anderson v. City of Bessemer City*, 470 U.S. 564, 573 (1985), *quoting United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948). *See generally* Fed. R. Civ. P. 52(a). This standard "plainly does not entitle a reviewing court to reverse the finding of the trier of fact simply because it is convinced that it would have decided the case differently." *Anderson v. City of Bessemer City*, 470 U.S. at 573. Where "there are two permissible views of the evidence, the factfinder's choice between them cannot be clearly erroneous." *Id.* at 574.

The district court held in this case that "in its attack under 35 U.S.C. § 103, FATA did not come close to rebutting the statutory presumption of validity, 35 U.S.C. § 282, that attaches to the '787 patent by establishing that Claim 1 of the '787 patent was invalid." (Pet. App. 58a). The court of appeals expressly held that the district court's findings of fact are not clearly erroneous and affirmed the court's judgment that respondent's '787 patent is not invalid. (Pet. App. 7a). This case is simply not "a strong case in which this Court will set aside these concurrent findings of two courts." *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. at 278. Indeed, petitioners state in their petition that "[t]his petition does not concern the factual determinations made below." (Pet. at 3). This Court should, therefore, deny the petition.

III. The Decision Below Is Correct.

The issue made the basis of the petition encompasses two arguments, neither of which was raised in or passed upon by the court of appeals. (Pet. App. 4a-7a). First, petitioners argue that the court below erred by "inquir[ing] into whether the prior art contained any teaching, suggestion or motivation to combine the references." (Pet. at 14). Second, petitioners argue that the court of appeals erred "by holding that commercial success trumped the *prima facie* case of obviousness based on the *Graham* primary factors." (Pet. at 15). Neither argument has any merit.

Section 103 of the Patent Act of 1952, 35 U.S.C. § 103,

> was intended to codify judicial precedents embracing the principle long ago announced by this Court in *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851), and that, while the clear language of § 103 places emphasis on an inquiry

> into obviousness, the general level of innovation necessary to sustain patentability remains the same.

Graham v. John Deere Co., 383 U.S. at 3-4.

Section 103 " 'provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts.' " *Id.* at 14, *quoting* S. Rep. No. 1979, 82d Cong., 2d Sess., 6 (1952) and H.R. Rep. No. 1923, 82d Cong., 2d Sess., 7 (1952). The condition of "nonobviousness," moreover, has been expressed " 'in a large variety of ways in decisions of the courts and in writings.' " *Id.*

The decision below is entirely consistent with decisions of this Court and decisions of the other courts of appeals. In *United States v. Adams*, 383 U.S. 39 (1966), decided on the same day as *Graham* and conveniently ignored by petitioners, the Court held that the patent was not invalid for obviousness. 383 U.S. at 41. In reaching its holding, the Court repeatedly referred to the "teachings" and "suggestions" in the prior art. *See, e.g.*, 383 U.S. at 46 ("The Wood patent is relied upon by the Government as *teaching* the substitution of magnesium"); *id.* at 47 (the treatise "does not *teach* that magnesium could be combined in a water-activated battery"); *id.* (the treatise "in no way *suggests* that cuprous chloride could be employed in a battery"); *id.* at 48 ("teachings") (emphasis added).

The decision below is also consistent with other decisions from this Court. In *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275 (1944), the Court concluded that the prior art had not "suggested" a solution to the problem. 321 U.S. at 278. In *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809 (1986) (per curiam), the Court referred to "teachings" of the prior art. 475 U.S. at 810. *See generally* Edmund W. Kitch, *Graham v. John Deere Co.: New Standards*

for Patents, [1966] Sup. Ct. Rev. 293, 328-29 (what the prior art "suggested" or "taught"). Before the creation of the Federal Circuit in 1982, the courts of appeals, both before and after this Court's decisions in *Graham* and *Adams*, routinely used the same or similar language when analyzing the issue of obviousness.[4] The common theme in all of these cases is that if a person of ordinary skill in the art did not know how to make the combination, as in this case, there must be some suggestion or teaching in the prior art for there to be a finding of obviousness.

4. *See, e.g., Mooney v. Brunswick Corp.*, 663 F.2d 724, 733 (7th Cir. 1981) (what the prior art "suggests"); *Smith v. Acme General Corp.*, 614 F.2d 1086, 1092 (6th Cir. 1980) ("what is taught by the prior art is of paramount importance to the determination of obviousness in this patent litigation"); *In re Gyurik*, 596 F.2d 1012, 1018 (C.C.P.A. 1979) ("the motivation of one having ordinary skill in the art to make it"); *Steelcase, Inc. v. Delwood Furniture Co.*, 578 F.2d 74, 79 (5th Cir. 1978), *cert. denied*, 440 U.S. 960 (1979) (obviousness "may be found from the teachings of the whole of the prior art and the improvement on those teachings that would be obvious to the hypothetical person of ordinary skill in the art"); *In re Regel*, 526 F.2d 1399, 1403 n.6 (C.C.P.A. 1975) (a "reason" or "suggestion"); *In re Luck*, 476 F.2d 650, 652 (C.C.P.A. 1973) ("teachings of the prior art"); *Preuss v. General Elec. Co.*, 392 F.2d 29, 32 (2d Cir.), ("teachings" of the prior art), *cert. denied*, 393 U.S. 834 (1968); *In re Uhlig*, 376 F.2d 320, 323 (C.C.P.A. 1967) ("a disclosure in a reference . . . . must be considered as a whole to ascertain what would be reasonably suggested to one of ordinary skill in the art"); *In re Shepard*, 319 F.2d 194, 197 (C.C.P.A. 1963) (the "teaching" of the prior art and what the prior art "suggests"); *Firestone v. Aluminum Co. of Am.*, 285 F.2d 928, 930 (6th Cir. 1960) ("teachings" of the prior art); *In re Eisenhut*, 245 F.2d 481, 486 (C.C.P.A. 1957) ("teachings of the prior art"); *In re Gruskin*, 234 F.2d 493, 498 (C.C.P.A. 1956) ("there is nothing in the references which would have suggested to one skilled in the art that the above teachings could have been combined to give appellant's toothpaste"); *In re Lieser*, 162 F.2d 224, 226 (C.C.P.A. 1947)("teaching of the prior art"); *Radtke Patents Corp. v. Coe*, 122 F.2d 937, 943 (D.C. Cir.), *cert. denied*, 314 U.S. 695 (1941) (what the prior art "suggested").

Of course, a "variance in the language used in opinions [by the Federal Circuit] does not change the nature of the statutory inquiry under section 103." *In re Oetiker*, 977 F.2d 1443, 1448 (Fed. Cir. 1992) (Niles, C.J., concurring). The "particular linguistic framework used is less important than whether the test used is probative of the essential inquiry," in this case obviousness. *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 40 (1997). This Court should, therefore, reject petitioners' plea to "micromanag[e] the Federal Circuit's particular word choice." *Id.* The Federal Circuit has simply "refine[d]" the formulation of the test for obviousness used by the courts of appeals before the creation of the Federal Circuit, and this Court should "leave such refinement to that court's sound judgment in this area of its special expertise." *Id.* In any event, this Court " 'reviews judgments, not statements in opinions,' " *FCC v. Pacifica Foundation*, 438 U.S. 726, 734 (1978), *quoting Black v. Cutter Labs.*, 351 U.S. 292, 297 (1956), and the decision below is correct under *Graham* and its progeny.

Finally, there is no merit to petitioners' argument that the court of appeals in this case erred "by holding that commercial success trumped the *prima facie* case of obviousness based on the *Graham* primary factors." (Pet. at 15). It is plain from the court's opinion that the court below in no way intimated, much less held, that the "secondary consideration" of commercial success "trumped" the three primary *Graham* factors as petitioners would have this Court believe. (Pet. App. 4a-7a). In fact, the secondary consideration of commercial success could not have trumped the three primary *Graham* factors because the court below affirmed the district court's decision that application of the three primary factors to the facts before it, standing alone, demonstrated that respondent's invention was not obvious. (Pet. App. 4a-7a). This Court should, therefore, deny the petition.

CONCLUSION

The petition for a writ of certiorari should be denied.

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